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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,941	11/21/2005	Paul F Worley	JHU1880-1	3136
28213	7590	11/05/2007		
DLA PIPER US LLP 4365 EXECUTIVE DRIVE SUITE 1100 SAN DIEGO, CA 92121-2133			EXAMINER SHEN, BIN	
			ART UNIT 1657	PAPER NUMBER
			MAIL DATE 11/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,941	Applicant(s) WORLEY, PAUL F	
	Examiner Bin Shen	Art Unit 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-41 is/are pending in the application.
- 4a) Of the above claim(s) 35-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 35-41 are withdrawn from further consideration.
Claims 1, 3-34 are presented for examination on the merits.

Specification

The disclosure is objected to because of the following informalities: on line 1, page 23 of paragraph [00099] of the specification, the figure number is missing; on line 3, page 24 of paragraph [000103] of the specification, the figure number is missing. Appropriate correction is required.

Claim Objections

Claims 25 and 26 are objected to because each claim is dependent on itself.

Claims 5, 20, 21, 28 are objected to because of the following informalities: the word "effect" is misspelled in claim 5, on line 2; the word "a" on line 3 of claim 20 should be replaced by --the--; the word "die" on line 2 of claim 21 should be replaced by --the--; the phrase "as set form" on line 1 of claim 28 should be replaced by --is set forth--. Appropriate correction is required.

Claims 16, 17 and 28 are objected to for the use of accession numbers.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825; applicant's attention is directed to the final rule making notice published at 55 FR 18230 (May 1, 1990),

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and 1114 OG 29 (May 15, 1990). To be in compliance, applicant is required to identify all amino acid sequences of at least 4 L-amino acids and at least 10 nucleotides by a sequence identifier, i.e., "SEQ ID NO:". A paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification, and a statement that the content of the paper and computer readable form copies are the same and where applicable, include no new matter as required by 37 CFR 1.821(e) or 1.821(f) Or 1.821(g) or 1.821(b) or 1.825(d).

Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 11 fails to further limit claim 1. Furthermore, claim 11 directs to a new set of different assays.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 31-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 31-34 refer to a modulating agent and its use without giving a true technical characterization. Moreover, no such specific agent is defined in the specification. The closest potential support for the claimed subject matter is in paragraph [0080] of the descriptive portion of the specification, where it gives examples of the function of the test compound. However, this does not actually provide support for the claim, no specific structural characteristic of such agent is provided, nor is there any indication that the applicant had possession of the claimed agent. One skilled in the art would conclude that the inventors were not in possession of the claimed invention, the claims fails to comply with the written description requirement. Further, since this Examiner can't determine what agent is claimed, it cannot be searched.

Claims 31-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to disclose any particular structure for the claimed agent. The specification does not provide any guidance or any working examples in this unpredictable art, and thus the artisan would have been unable

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to prepare the claimed agent. Furthermore, a method for screening an agent is not equivalent to a positive recitation of how to make a product. The claims fail to meet the enablement requirement for the "how to make" prong of 35 U.S.C. 112, first paragraph. Furthermore, for a method of treating neurodisorders, claims 31-34 present no information as to how the undisclosed agent would have been administered to treat neurodisorders. Thus, the skilled artisan would not been able to practice the steps required by the claimed invention.

The Following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rendered vague and indefinite by the phrase "protein or peptide" on line 8 for the following reason. The protein or peptide in step (i) will form a mixture in contacting other reagents. It is suggested that claim 1 be amended to recite -"mixture formed in"- to more clearly define the limitation, and that dependent claims reciting such limitations also be amended accordingly. In the determining step, a control is missing when comparing if Homer binding is increased or decreased. It is suggested that claim 1 be amended to insert -

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"compared to the absence of the test agent"- to more clearly define the limitation.

Claim 11 recites a series of different endpoint assay. There is insufficient antecedent basis for this limitation in the claim.

Claim 29 recites Homer protein with point mutations, which have different amino acid/nucleotide sequences of Homer protein in claim 1. There is insufficient antecedent basis for this limitation in the claim.

All other claims depend directly or indirectly from rejected claims and are, therefore, also rejected under USC 112, second paragraph for the reasons set forth above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 7, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Xiao et al. (Current Opinion in Neurobiology 2000:10:370-374).

Xiao teach a role for Homer complexes in signal transduction, synaptogenesis and receptor trafficking (abstract), a method to study Homer complexes by immunoprecipitation in the absence of a peptidylproline cis-trans isomerase (PPIase) (read as wherein the PPIase inhibitor

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is present in at least two concentration, wherein at least one concentration of the inhibitor does not inhibit Homer binding to the at least one protein or peptide).

Therefore, the cited reference is deemed to anticipate the instant claims above.

Applicant's argument with regard to the rejection under 35 USC §103 are duly noted and deemed to be persuasive and the rejection is hereby withdrawn.

Conclusion

Claims 1, 3-4, 8-9 12-15, 19, 22-24, 27 are allowable if amended according to Examiner's suggestions.

Certain papers related to this application may be submitted to Art Unit 1657 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is 571-273-8300. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance.

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Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

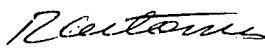
For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Any inquiry concerning rejections or objections in this communication or earlier communications from the examiner should be directed to Bin Shen, Ph.D., whose telephone number is (571) 272-9040. The examiner can normally be reached on Monday through Friday, from about 9:00 AM to about 5:30 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to her office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached at (571) 272-0925.

B Shen

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